



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/198,376	11/24/1998	AKIRA OKAMOTO	NU-98035	2418

7590

01/24/2002

WHITHAM CURTIS AND WHITHAM
RESTON INTERNATIONAL CENTER
11800 SUNRISE VALLEY DRIVE
SUITE 900
RESTON, VA 20191

EXAMINER

FLANIGAN, ALLEN J

ART UNIT

PAPER NUMBER

3743

DATE MAILED: 01/24/2002

#28

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/198,376

Applicant(s)

OKAMOTO ET AL.

Examiner

Allen J. Flanigan

Art Unit

3743

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 05 December 2001 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 26

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☒ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). 14, 26.
10. ☒ Other: Note the attached PTO 892, Notice of References Cited

Allen J. Flanigan
Primary Examiner
Art Unit: 3743

Continuation of 5. does NOT place the application in condition for allowance because: The Examiner has consistently maintained (see Office action mailed 12/15/199 and subsequent actions) that the substitution of one thermochromic material for an equivalent material would have been obvious in light of Benson et al.'s explicit suggestion in this regard, and has consistently asserted that the claimed perovskite material is a known material whose properties are known. Applicant has not clearly challenged this position until now, raising the issue of whether the challenge is seasonal and if in fact the well known nature of the substance claimed, and its properties, can be taken as admitted prior art. See MPEP 2144.03, In re Chevenard, 60 USPQ 239. Nevertheless, the cited Urushibara et al. reference, cited in the Shimazaki et al. reference cited on 12/18/01 by the applicant (a copy of which is provided herein) supports the Examiner's position in this regard.

Claim 26 would be rejected over the art of record (Teeg et al. and Benson et al.), with Urushibara et al. cited to support the Examiner's long-standing assertion regarding the well-known nature of the claimed materials and their properties.